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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/366,935 08/04/99 MIYAMOTO

H YAMAP0398USB

EXAMINER

IM22/0130

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ART UNIT

PAPER NUMBER

1733

DATE MAILED:

4
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/366,935

Applicant(s)
Miyamoto et al.

Examiner
Mike Tolin

Group Art Unit
1733



☒ Responsive to communication(s) filed on Oct 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 50 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 50 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/599,181.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The first sentence of the specification which makes a reference to the parent applications should be amended to indicate that Application 08/861,940 is now U.S. Patent No. 5,972,250.

See MPEP 201.11.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 8 it is unclear what "cured interposed therebetween" means. It appears that the intended scope is --a table for integrally rotating the first and second substrates, with the radiation curable resin [before being cured] interposed therebetween, before the radiation curable resin is cured;--.

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In line 11, the scope of “through the center holes of the first and second substrates” is unclear because Applicant’s Fig. 6 shows that the means for absorbing is at a position within center holes, but the resin is not absorbed through the center holes. The examiner suggests clarifying the claim language to indicate that the substrates are positioned on the table and the “means for absorbing” is positioned to absorb the radiation curable resin at a position within center holes of the first and second substrates while the substrates are on the table.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 50 is rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi (US 4995799).

Hayashi shows an apparatus having a rotary table and means 32 for absorbing resin between layer 15 and substrate 29. Substrate 29 is an optical disc substrate, layer 15 is a stamper having optical information thereon, and a radiation curable resin is provided between layer 15 and substrate (Fig. 4). The claim recites functional language for bonding a first and second substrate to form an optical information medium and functional language for absorbing such that resin is

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absorbed through the center holes of the substrates. However, an apparatus is claimed, not a method. To meet the claims, it is only required that the apparatus of Hayashi is capable of being used for bonding first and second optical storage medium substrates and that the absorbing means 32 of Hayashi is capable of absorbing resin through the center holes of optical storage medium substrates having resin therebetween. The examiner's position is that Hayashi is capable of operating in this manner because the substrates with adhesive therebetween can be placed on the rotary table of Hayashi such that the absorbing means 32 is positioned inside the center holes of the substrates.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inouchi (US 5843257), Kitano '670 (US 5800670), and Kitano '193 (US 5744193) each clearly disclose an apparatus for bonding optical disc substrates having a rotary table and a suction means for absorbing adhesive, the suction means positioned within the center holes of the substrates. However, these references do not qualify as prior art against the current application.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Tolin whose telephone number is (703) 305-6618. The examiner can normally be reached on Monday-Thursday from 9:30am to 8pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for official after final faxes, and whose fax number is (703) 305-7718 for all other official faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

January 22, 2001

Michael Tolin

Patent Examiner

Michael A. Tolin